

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 8/22/08 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 8/22/08 has been received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner. A signed 1449 is enclosed with this office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 23, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 23 is indefinite over the recitation “probe sets are labeled by nick translation.” This limitation is confusing because it is not clear if it is an attempt to add an additional process step to the claims- wherein the actual process of nick translation takes place- and if so, when this would occur, or if it is an attempt to simply recite that the probe sets which contain labeled fragments were prepared by nick translation. Likewise, claims 24 and 25 recite similar limitations and are indefinite for analogous reasons. If applicant intends the latter, amendment of claim 23 to recite that the probe sets “were” labeled by nick translation would clarify this matter.

Double Patenting

7. Claims 8, 10, 11, 12, 16, and 23-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-25 of copending Application No. 11/278410. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 8, 11, and 12 are anticipated by the claims of the copending application. The copending claims do not teach the hybridization wash conditions, that the sample contains cervical cells or the techniques used to label the probe sets. However, each of these were methodologies which were routinely practiced in the technology at the time the invention was made. It would have been obvious to one skilled in the art to have modified the copending application methods so as to have used these techniques.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C Switzer whose telephone number is (571) 272-0753. The

examiner can normally be reached on Tuesday or Wednesday, from 9:00 AM until 4:30 PM, and Thursday from 12:15 PM until 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached by calling (571) 272-0735.

The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0507.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-

Art Unit: 1634

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*/Juliet C. Switzer/
Primary Examiner
Art Unit 1634*

November 7, 2008